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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,064	12/03/2004	Luc Mocns	2004-1911A	8726

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WENDEROTH, LIND & PONACK, L.L.P.
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SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

TOSCANO, ALICIA

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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12/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,064

Applicant(s)

MOENS ET AL.

Examiner

Alicia M. Toscano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/13/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Rejection over claim 22 is overcome by amendment.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 13-21, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moens (US 5397641) in view of Kaplan (US 587192) and Barkac (US 6191225).

This rejection is as set forth in the action dated 6/11/07.

Applicant's amendment only requires that the thermosetting coating has a gloss value. There is no limit on the gloss value. Since the compositional elements are met, as previously set forth, the Examiner finds the coating to inherently have a gloss.

See additional comments below.

3. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moens (US 5397641), Kaplan (US 587192) and Barkac (US 6191225) in further view of Kaplan (US 6313234).

This rejection is as set forth in the action dated 6/11/07. See comments below.

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4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moens, Kaplan '192 and Barkac in further view of Hoebeke (US 5525370).

This rejection is as set forth in the action dated 6/11/07. See comments below.

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moens, Kaplan '192 and Barkac in further view of Knoops (WO 02055620).

This rejection is as set forth in the action dated 6/11/07. See comments below.

Conclusion

Response to Arguments

1. Applicant's arguments filed 11/13/07 have been fully considered but they are not persuasive. Applicant's amendment is met by the previous limitations, as set forth above.
2. Applicant argues the rejection picks features from multiple documents without providing credible motives to combine. Applicant argues the rejection cherry picks combinations of features out of context, thusly using impermissible hindsight.

Examiner disagrees. The motivation to combine references is as set forth previously. Applicant argued to the improper use of motivation in the Remarks filed 5/11/07. See Examiner's response numbers #12, 13 and 15 in the previous action, which detail the motivation to combine. The motivation set forth and responded to

previously is proper for the reasons set forth previously, and reasons further detailed below. The rejections thusly stand.

3. Applicant argues Moens does not teach semi-gloss compositions.

Examiner submits this as moot since the claims are not drawn to semi-gloss compositions. Since a semi-gloss composition is not required, further arguments made by Applicant corresponding to the gloss of the compositions will not be further addressed.

4. Applicant argues one would not cross reference with Barkac without impermissible hindsight, and that one would not refer to Barkac to achieve semi-gloss. Applicant argues the two line statement of Barkac regarding use of crystalline or amorphous carboxyl polyesters hardly supports a general contention that all crystalline and amorphous carboxyl functional polyesters are equivalent.

Examiner disagrees. Motivation to include Barkac is proper, ie, one looking to make thermosetting powder compositions, which are taught by both Moens and Barkac, would look to Barkac for the teaching that crystalline and amorphous polyesters functionalize equivalently in thermosetting powder compositions. If Applicant wishes to pursue said argument, the Examiner requests evidence that crystalline and amorphous polyesters do not function equivalently in thermosetting compositions of the instant claims. The motivation is proper and stands.

5. Applicant argues the rejection regarding the functional equivalence of semi-crystalline and amorphous carboxyl functional polyesters is sweeping statement which is not justified by Kaplan.

Examiner disagrees. It is unclear why, when Kaplan teaches the functional equivalence of the polyesters, one would not use them interchangeably. The motivation is proper and stands. If Applicant wishes to pursue said argument the Examiner requests evidence that they do not functionalize equivalently in the instant case.

6. Applicant argues the rejection does not provide proper reasons to combine Kaplan '234 without using hindsight. Applicant argues Kaplan '234 is concerned with curing agents designed for different systems than that of Moens and that mixing things taught for the purpose is not necessarily obvious. Applicant argues a curing system designed for one system (containing TGIC as in Kaplan '234) cannot be assumed to work in a system without TGIC. Applicant argues there is no motive to use curing agents designed for different systems.

Examiner disagrees. Kaplan is used solely to teach the functional equivalence of the specific beta-hydroxyalkylamide to other polyfunctional epoxy compounds. That the compositions of Moens and Kaplan are similar, but not exactly the same, is moot. One would expect the curing agent to functionalize equivalently between the same reactive endgroups (carboxyl functional polymers) no matter the system the carboxyl functional polymers were contained in. The motivation is proper and thusly stands. If Applicant wishes to pursue said argument the Examiner requests evidence that they do not functionalize equivalently in the instant case.

7. Applicant notes that the inventor label of WO 02/055620 should be Moens, instead of Knoops. Both inventors are named in the WO document, Examiner used Knoops in order to keep the record straight, since there are multiple Moens references

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used in the rejection and since Knoops comes up as the inventor's name in the Notice of References cited sheet attached to the office action.

8. Applicant argues the use of a glycidyl acrylate polymer with a Mn greater than 10,000 has been imported from Hoebeke or Moens (Knoops) without proper reasons. Applicant argues Moens would not refer to Hoebeke because Hoebeke describes matte coatings whereas Moens is drawn to high gloss. Applicant argues the rejection cherry picks arbitrary features from the prior art and that without the advanced knowledge of the present invention one would not be motivated to combine the references. Applicant argues Knoops teaches away from the present invention and is thusly improper to combine the references. Applicant argues the present invention uses amorphous polyesters to achieve semi-gloss coatings and this is surprising giving the teachings of Knoops.

Examiner disagrees. Hoebeke teaches the Mn of the specified range to result in superior coating properties. One would thusly look to Hoebeke when desiring improved properties. That Hoebeke is drawn to matte coatings is moot since Hoebeke is used solely to teach why one would want to use the Mn range. Similarly, Knoops is used to teach that the Mn is a result effective variable and one would be motivated to use a high Mn when one desires a low gloss product. The motivation set forth is proper and the rejections stand. Applicant's arguments drawn to impermissible hindsight are moot since one looking to include the above elements has proper motivation to do so.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

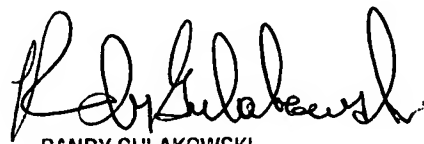
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Toscano whose telephone number is 571-272-2451. The examiner can normally be reached on Monday to Friday 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMT



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